

REMARKS

Claims 1-12 and 14-19 are pending in this application. Claim 13 was previously canceled without prejudice or disclaimer. Claims 10-12 and 14-16 were previously withdrawn from consideration as being directed to a non-elected invention.

Claims 1 and 10 have been amended to more clearly point out what applicants regard as their invention. Specifically, these claims have been amended to recite that the fluorine compound is a compound in which hydrogen atoms of a hydrocarbon compound are partially or completely substituted with fluorine atoms, and is modified with one or more reactive functional groups specified in the claims. Support for this amendment can be found in paragraphs 0022 and 0023 on pages 18-20 of the specification. Similarly, claims 3 and 12 were amended to specify that the liquid or developer comprises the silicone compound and also specify the functional groups. Finally, claim 7 was amended to recite that the liquid comprises the fluorine compound. Accordingly, no new matter has been introduced by these proposed amendments.

Rejection: §112, 2nd paragraph

Claims 3-9 were rejected under 35 USC §112, 2nd paragraph because the recitation of "modifying groups" rendered the claims indefinite. Claims 3-9 have been amended to avoid reciting terms that have no antecedent basis, even though the meaning of the original text would have been clear to those skilled in the art. Accordingly, this rejection should be withdrawn.

Rejection: § 102

Claims 1-6, 8, 9 and 17-19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshida (U.S. Patent No. 6,403,284). The Office asserts that

Yoshida teaches each limitation of these claims. These claims as amended clearly distinguish over the teachings of Yoshida because Yoshida neither teaches nor suggests applying a liquid comprising a silicone or fluorine compound within the scope of the present claims. Yoshida does disclosure applying a hydrogen-abstracting compound that may contain a fluorine atom, but these compounds described at col. 5, line 39 to col. 7, line 44 are organic carbonyl compounds that do not fall within the scope of the present claims.

The compound of formula (1) is not a hydrocarbon, and even if the compound of formula (II) was regarded as a hydrocarbon possibly substituted by fluorine (R_4), the functional group attached to the hydrocarbon would always require the carbonyl group at a minimum and would fall outside the scope of the present claims. Since Yoshida does not meet each limitation of the present claims, it cannot anticipate any one claim. In addition, claims 3 and 12 have been amended to require the presence of the silicone compound which is not taught in Yoshida. Accordingly, this rejection should be withdrawn.

Rejection: § 103

Claims 1, 3-6, 8, 9 and 17-19 have been rejected under 35 U.S.C. § 103 as being unpatentable over Fuji (U.S. 2002/0182543 A1) in view of Yoshida. The Office argues that Fuji discloses a method of producing a water-developable photopolymer plate that comprises an exposure step, a development step, and a post-exposure step. The Office acknowledges that Fuji does not disclose a contact step that brings the photopolymer plate into contact with a silicone or fluorine compound within the scope of the present claims, but relies on Yoshida as teaching a surface-treating solution that is

alleged to possibly fall within the scope of the claims if the selection of possible substituents is made in a manner which would fall within the scope of the present claims.

As discussed above, however, these claims have been amended so that they do not read on any possible compound disclosed by Yoshida as a hydrogen abstracting compound. Accordingly, even if the teachings of Yoshida were combined with those of Fuji, it would not lead to the claimed invention as not all limitations of any one claim under rejection could be met by this combination. Accordingly, this rejection should be withdrawn.

Prompt and favorable reconsideration is requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 20, 2010

By: Charles E. Van Horn
Charles E. Van Horn
Reg. No. 40,266
(202) 408-4000